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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,060	11/25/2003	Donal Coveney	122359.00003 (TOMK-0001)	4165
25555	7590	07/26/2006	EXAMINER	
JACKSON WALKER LLP 901 MAIN STREET SUITE 6000 DALLAS, TX 75202-3797			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,060

Applicant(s)

COVENEY ET AL.

Examiner

Taylor Victor Oh

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7-9, 12-14 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 and 7-9 is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☒ Claim(s) 16-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1625

Applicant's arguments with respect to claims 1-4, 7-9, 12-14, and 16-18 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims:

Claims 1-4, 7-9, 12-14, and 16-18 are pending.

Claims 12-14 has been rejected.

Claims 1-4, and 7-9 are allowable.

Claims 16-18 are objected.

DETAILED ACTION

Priority

1. None.

Drawings

2. None.

Claim Objections

Claims 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method for treatment of viral infection for HIV-1 infection, does not reasonably provide enablement for all viral infections. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to include all the viral infections unrelated to the invention commensurate in scope with these claims. The following is the general information of the viral infection as shown in Merck manual Home edition ,Feb. 1 ,2003):

Viruses usually infect one particular type of cell. For example, cold viruses infect only cells of the upper respiratory tract. Additionally, most viruses infect only a few species of plants or animals; some infect only people.

Probably the most common viral infections are those of the nose, throat, and airways. These infections include sore throat, sinusitis, the common cold, and influenza. Doctors often refer to these as upper respiratory infections (URIs). In small children, viruses also commonly cause croup and inflammation of the windpipe (laryngitis) or other airways deeper inside the lungs (bronchiolitis, bronchitis (see Respiratory Disorders: Bronchiolitis).

Some viruses (for example, rabies, West Nile virus, and several different encephalitis viruses) infect the nervous system (see Infections of the Brain and Spinal Cord: Viral Infections). Viral infections also develop in the skin, sometimes resulting in warts or other blemishes (see Viral Skin Infections: Warts). Additionally, many viruses commonly infect infants and children (see Viral Infections: Introduction).

Art Unit: 1625

Other common viral infections are caused by the herpesviruses. Eight different herpesviruses infect people. Three of these—herpes simplex virus type 1, herpes simplex virus type 2, and varicella-zoster virus—cause infections that produce blisters on the skin. Another herpesvirus, Epstein-Barr virus, causes infectious mononucleosis. Cytomegalovirus is a cause of serious infections in newborns and in people with a weakened immune system. It can also produce an illness similar to infectious mononucleosis in people with a healthy immune system. Human herpesviruses 6 and 7 cause a childhood illness known as roseola infantum (see Viral Infections: Roseola Infantum). Human herpesvirus 8 has been implicated as a cause of cancer (Kaposi's sarcoma) in people with AIDS.

In view of this information, it becomes clear that the specification has failed to describe treatments of any kinds of the viral infections, such as , upper respiratory tract viral infection, the viral infections caused by rabies, West Nile virus, encephalitis virus, and etc. by using the claimed compounds. Furthermore, many viruses have a different way of attacking target cells and a different mode of infecting, propagating their viral genetic materials; thus, it is highly improbable that the claimed compounds of formula I would act as a silver bullet to treat all kinds of viral infections regardless of their causes.

Therefore, an appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claim , " a mixture of compounds of formula I" is recited. This expression is vague and indefinite because this limitation does not elaborate what the mixture of

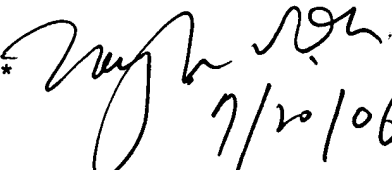
Art Unit: 1625

compounds of formula I is described; this should be dependent on some independent claim with the " formula I". Therefore, an appropriate correction is required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


7/20/06